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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,024	11/15/2001	Takashi Futagawa	56694	5035

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/23/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,024

Applicant(s)

FUTAGAWA ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. The declaration under 37 CFR 1.132 filed May 12, 2003 is insufficient to overcome the rejection of claims 1-12, 14-15, and 17-18 based upon the 35 U.S.C. 103 rejection over Futagawa (JP-11-077937) as set forth in the last Office action because:

The shape factor is shown in the declaration to depend on multiple factors such as temperature and cooling water feed rate, which it is not understood how these conditions are determined specifically for experiments 2-4, which are supposed to represent the Futagawa reference. Since the Futagawa reference does not teach a specific cooling water feed rate, how can it be determined that Futagawa does not also teach a cooling water feed rate greater than 10L/min. There is no evidence provided to defend the statement that there is no document which is published prior to the filing date of the reference, which describes the amount of cooling water fed in the water-quenching method. Also, the statement would be more persuasive if provided by a disinterested person rather than the applicant himself. Furthermore, if the cooling water feed rate is the only difference in the two laminates that difference must be included in the claims in order for the unexpected results

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presented in the declaration to be commensurate in scope with the claims. As the claims currently read, there is no difference between the laminate of the reference and the claimed laminate other than a latent property without any sound proof that the reference laminate does not include the latent property. The evidence presented in the declaration teaches a limitation that is not in the claims as the difference in the two laminates.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 112 rejections of claims 8, 11, 13 and 15 of record in Paper #7, Pages 2-4 Paragraph 1 have been withdrawn due to applicant's amendment in Paper #10.

3. The 35 U.S.C. 102 rejections of claims 1-12, 14-15, and 17-18 of record in Paper #7, Pages 4-5 Paragraph 2 have been withdrawn due to Applicant's arguments in Paper #10.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12, 14-15, and 17-18 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 17 and 18, the limitation of the outermost layer having a shape factor and the method of determining the shape factor is indefinite and vague. It is not understood whether the outermost layer contains a shape factor or if the shape factor is a measurement. It is also not understood if "a peak shape of Raman spectrum" is being claimed as a component of the outermost layer or merely describing the method of determining frequency peaks that are used to determine the shape factor. Shape factor is not defined to a point that enables one of ordinary skill in the art to understand what is referred to as a shape factor. Note that methods of measuring articles for determining certain values receive little patentable weight in article claims, because articles are defined by structure not merely stating intended results and special methods to determine the intended results.

REPEATED REJECTIONS

5. The 35 U.S.C. 103 rejections of claims 1-12, 14-15, and 17-18 over Futagawa are repeated for the reasons previously of record in Paper #7, Pages 6-9 Paragraph 3.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 112 rejections of claims 8, 11, 13, and 15 have been considered but are moot since the rejections have been withdrawn.

7. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 102 rejections of claims 1-18 as anticipated by Futagawa have been considered but are moot since the rejections have been withdrawn.

8. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 103 rejections of claims 1-18 over Futagawa have been fully considered but they are not persuasive.

In response to applicant's argument that Futagawa fails to teach that the shape factor of the outermost layer is not less than 2.2 as claimed in claim 1. However, it is not persuasive by evidence that the Futagawa reference does not teach using an

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amount of water cooling feed greater than 10 L/min during the water-quenching method, which would provide the laminate with a shape factor greater than 2.2 as determined by a Raman spectrum. Futagawa teaches that the laminate is required to have low curling, and through routine experimentation one of ordinary skill in the art would have selected the parameters required to produce a laminate with the lowest curl possible. Therefore, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to produce the laminate taught by Futagawa using the water-quenching method of Futagawa with the lowest possible curl, because the higher the curl the higher the chance of separation of the bag from the product, as taught by Futagawa, and the laminate with the lowest curl has a shape factor greater than 2.2 as determined by Raman spectrum. Furthermore, mere recognition of latent properties, such as the shape factor of a layer determined by Raman spectrum, in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to

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Christopher P Bruenjes whose telephone number is 703-305-3440.

The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB

July 14, 2003



ALEXANDER S. THOMAS
PRIMARY EXAMINER